

REMARKS

STATUS OF CLAIMS

Claims 20-21, 23, 28, 30-31, 33-34, 37, and 39-40 are pending. By this Amendment, claims 1-19, 24, 26, and 42-44 have been cancelled. Claims 20 and 33 have been amended to further define the methods of use. Support for these amendments can be found in original claims 42-44, and in the originally filed specification, for example on page 6, lines 3-9 and page 19, lines 17-20. Applicants also hereby introduce new claims 45-71. Support for these claims can be found in original claims 26 and 43-44, and the originally filed specification, for example at page 6, lines 3-9 and page 8, line 18 to page 16, line 15. No new matter has been added.

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 20-21, 23, 28, 30-31, 33-34, 37, 39-40, and 45-71 in condition for allowance. Applicants submit that the proposed amendments of claims 20 and 33 and introduction of new claims 45-71 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicant's invention. It is respectfully submitted that the entering of the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

REJECTIONS UNDER § 103

1. *Crawford in view of Samson*

The Examiner has rejected claims 1-4 and 8-10 under 35 U.S.C. § 103(a) as being unpatentable over GB 2048935 to Crawford (hereinafter "Crawford") in view of U.S. Patent No. 4,605,808 to Samson (hereinafter "Samson") for the reasons set forth in paragraph 2 of the present Office Action. See page 2 of the present Office Action. Claims 1-4 and 8-10 have been cancelled, thereby rendering their rejections moot. Applicants respectfully request reconsideration and withdrawal of the rejection.

2. *Crawford in view of Samson in view of Papay*

The Examiner has rejected claims 1, 7, 11, 13, 15-16, and 18-19 under 35 U.S.C. § 103(a) as being unpatentable over *Crawford* in view of *Samson* and further in view of U.S. Patent No. 5,652,201 to Papay (hereinafter "Papay") for the reasons set forth in paragraph 3 of the present Office Action. See *id.* Claims 1, 7, 11, 13, 15-16, and 18-19 have been cancelled, thereby rendering their rejections moot. Applicants respectfully request reconsideration and withdrawal of the rejection.

3. *Crawford in view of Papay in view of Samson in view of Lundberg*

The Examiner has rejected claim 6 under 35 U.S.C. § 103(a) as being unpatentable over *Crawford* in view of *Papay* in view of *Samson* and further in view of U.S. Patent No. 4,971,711 to Lundberg (hereinafter "Lundberg") for the reasons set forth in paragraph 4 of the present Office Action. See page 3 of the present Office

Action. Claim 6 has been cancelled, thereby rendering its rejection moot. Applicants respectfully request reconsideration and withdrawal of the rejection.

4. Crawford in view of Samson and Papay in view of Lambert

The Examiner has rejected claims 20-23, 26, 28, 30-31, 33-35, 37, 39-40, and 42-44 under 35 U.S.C. § 103(a) as being unpatentable over *Crawford* in view of *Papay* in view of *Samson* and further in view of U.S. Patent No. 5,888,947 to Lambert (hereinafter "Lambert") for the reasons set forth in paragraph 5 of the present Office Action. See *id.* In particular, it is the Examiner's position that *Crawford* in view of *Papay* and *Samson* do not disclose a method for reducing wear in moving parts with the lubricant composition. See page 5 of the Final Office Action mailed 3-12-2007. However, the Examiner has relied upon *Lambert* for overcoming this deficiency and asserts that "using the lubricant composition of *Crawford* in the method of reducing wear taught by *Lambert* meets claims 20-22." See para. 5 of the present Office Action and the Office Action mailed 7-27-2007. Applicants disagree and respectfully traverse the rejection for at least the following reasons.

Claims 22, 26, 32, 35, and 42-44 have been cancelled, thereby rendering their rejections moot. Moreover, presently amended claim 20 recites a method of reducing wear in an internal combustion engine comprising using as the crankcase lubricating oil for said engine a lubricant, as presently claimed. Additionally, presently amended claim 33 recites a method of lubricating a crankcase in an internal combustion engine comprising using in said crankcase a lubricant as presently claimed. However, neither *Crawford*, *Samson*, *Papay*, nor *Lambert* teach or suggest a method of reducing wear in

an internal combustion engine comprising using a particular crankcase lubricating oil, or a method of lubricating a crankcase.

Furthermore, although it is the Examiner's position that "*Lambert*...teaches that lubricants help prevent scuffing..." such a general proposition does not provide a sufficient teaching or suggestion for the methods recited in presently amended claims 20 and 33, directed to methods of lubricating a crankcase and of reducing wear in an internal combustion engine comprising using a particular crankcase lubricating oil, thereby rendering the present invention obvious. One of ordinary skill in the art would understand that crankcase oils are subjected to high temperatures and high pressures, which contribute to extreme wear conditions. Thus, crankcase oils must protect against more than mere "scuffing," due to their severe environment. Therefore, because *Lambert* fails to teach or suggest the presently claimed methods, the reference also does not overcome the deficiencies of *Crawford* in view of *Papay* in view of *Samson*.

Accordingly, the present invention is not obvious in light of *Crawford* in view of *Samson* in view of *Papay* and further in view of *Lambert*. Applicants respectfully request reconsideration and withdrawal of the rejection.

5. *Crawford* in view of *Samson*, *Papay*, and *Lambert* in view of *Galka*

The Examiner has rejected claim 23 under 35 U.S.C. § 103(a) as being unpatentable over *Crawford* in view of *Samson*, *Papay*, and *Lambert* as applied to claims 20-23, and further in view of U.S. Patent No. 6,427,647 to Galka (hereinafter "Galka") for the reasons set forth in paragraph 6 of the present Office Action. In particular, the Examiner has relied upon *Galka* for disclosing an internal combustion

engine and for teaching that gasoline may be used to power said engine. See *id.*

Applicants respectfully traverse the rejection for at least the following reason.

Claim 23 depends from independent claim 20 and is patentable for the same reasons, as discussed above. Specifically, *Galka* fails to teach or suggest a method of reducing wear in an internal combustion engine comprising using a particular crankcase lubricating oil. In fact, *Galka* is silent on the issue of how to reduce wear in an internal combustion engine, much less teach or suggest using a particular crankcase lubricating oil to reduce wear. As discussed above, a skilled person would understand that crankcase oils are subjected to high temperatures and high pressures, which contribute to extreme wear conditions. Thus, crankcase oils must provide adequate wear protection even in severe environments that accelerate wear. Accordingly, the present invention is not obvious in light of *Crawford* in view of *Samson*, *Papay*, and *Lambert* and further in view of *Galka*. Applicants respectfully request reconsideration and withdrawal of the rejection.

6. *Crawford* in view of *Samson*, *Papay*, and *Lambert* in view of *Albertson*

The Examiner has rejected claim 24 under 35 U.S.C. § 103(a) as being unpatentable over *Crawford* in view of *Samson*, *Papay*, and *Lambert* in view of U.S. Patent No. 3,653,273 to *Albertson* (hereinafter “*Albertson*”) for the reasons set forth in paragraph 7 of the present Office Action. See *id.* at pages 3-4. Claim 24 has been cancelled, thereby rendering its rejection moot. Applicants respectfully request reconsideration and withdrawal of the rejection.

7. Crawford in view of Tokumoto

The Examiner has rejected claims 1-4 and 8-10 under 35 U.S.C. § 103(a) as being unpatentable over *Crawford* in view of U.S. Patent No., 6,300,444 to Tokumoto (hereinafter "Tokumoto") for the reasons set forth in paragraph 8 of the present Office Action. See *id.* at page 4. Claims 1-4 and 8-10 have been cancelled, thereby rendering their rejections moot. Applicants respectfully request reconsideration and withdrawal of the rejection.

8. Crawford in view of Tokumoto and further in view of Papay

The Examiner has rejected claims 1, 7, 11, 13, 15-16, and 18-19 under 35 U.S.C. § 103(a) as being unpatentable over *Crawford* in view of *Tokumoto* and further in view of *Papay*. See page 4 of the present Office Action. Claims 1, 7, 11, 13, 15-16, and 18-19 have been cancelled, thereby rendering their rejections moot. Applicants respectfully request reconsideration and withdrawal of the rejection.

9. Crawford in view of Papay in view of Tokumoto and further in view of Lundberg

The Examiner has rejected claim 6 under 35 U.S.C. § 103(a) as being unpatentable over *Crawford* in view of *Papay* in view of *Tokumoto* and further in view of *Lundberg* for the reasons set forth in paragraph 10 of the present Office Action. Claim 6 has been cancelled, thereby rendering its rejection moot. Applicants respectfully request reconsideration and withdrawal of the rejection.

10. Crawford in view of Tokumoto in view of Papay and further in view of Lambert

The Examiner has rejected claims 20-23, 26, 28, 30-31, 33-35, 37, 39-40, and 42-44 under 35 U.S.C. § 103(a) as being unpatentable over *Crawford* in view of *Tokumoto* and *Papay* for the reasons set forth in paragraph 11 of the 3-12-2007 Office Action. See *id.* at pages 4-5. Applicants respectfully traverse the rejection.

Claims 22, 26, 32, 35, and 42-44 have been cancelled, thereby rendering their rejections moot. Moreover, *Lambert* does not overcome the deficiencies of *Crawford*, *Tokumoto*, and *Papay* for the same reasons discussed above. In particular, *Lambert* does not teach or suggest a method of lubricating a crankcase, or a method of reducing wear in an internal combustion engine comprising using a particular crankcase lubricating oil. Rather, the reference simply makes a blanket statement about how motor oils generally function (see col. 1, lines 29-30), which is certainly not a teaching or suggestion of the methods presently claimed. As discussed above, a skilled person would understand that crankcase oils are subjected to high temperatures and high pressures, which contribute to extreme wear conditions. Thus, crankcase oils must provide adequate wear protection even in severe environments that accelerate wear. Therefore, because *Lambert* fails to teach or suggest the presently claimed methods directed to lubricating a crankcase and to reducing wear in an internal combustion engine comprising using a particular crankcase lubricating oil, the reference also does not overcome the deficiencies of *Crawford* in view of *Tokumoto* in view of *Papay*.

Accordingly, the present invention is not obvious in light of *Crawford* in view of *Tokumoto* in view of *Papay* and further in view of *Lambert*. Applicants respectfully request reconsideration and withdrawal of the rejection.

11. *Crawford* in view of *Tokumoto*, *Papay*, and *Lambert* in view of *Galka*

The Examiner has rejected claim 23 under 35 U.S.C. § 103(a) as being unpatentable over *Crawford* in view of *Tokumoto*, *Papay*, and *Lambert* as applied to claims 20-23, and further in view of *Galka* for the reasons set forth in paragraph 12 of the 3-12-2007 Office Action. See *id.* at page 5. Applicants respectfully traverse the rejection.

Claim 23 depends from independent claim 20 and is patentable for the same reasons, as discussed above. Specifically, *Galka* fails to teach or suggest a method of reducing wear in an internal combustion engine comprising using a particular crankcase lubricating oil. In fact, *Galka* is silent on the issue of how to reduce wear in an internal combustion engine, much less teach or suggest using a particular crankcase lubricating oil to reduce wear.

Accordingly, the present invention is not obvious in light of *Crawford* in view of *Samson*, *Papay*, and *Lambert* and further in view of *Galka*. Applicants respectfully request reconsideration and withdrawal of the rejection.

12. *Crawford* in view of *Samson*, *Papay*, and *Lambert* in view of *Albertson*

This rejection is the same as that discussed in paragraph 6. Applicants respectfully request reconsideration and withdrawal of the rejection for the same reasons discussed above.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 50-2961.

Respectfully submitted,

Dated: April 21, 2008

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